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TO: Dilek B. Cobanoglu
Group Art Unit 3626

FROM: Michael K. O'Neill

RE: U.S. Application No. 10/782,902
Atty. Docket No.: -3191.000100

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MESSAGE

Attached is a Response to the Final Office Action dated July 26, 2007.

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OCT 26 2007

Response Under 37 C.F.R. § 1.116
Group Art Unit 3626, Expedited Procedure

03191.000100

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
: Examiner: D. Cobanoglu
MAX STANFORD TOMLINSON, JR., et al)
: Group Art Unit: 3626
Application No.: 10/782,902)
: Filed: February 23, 2004)
: For: METHOD FOR PAYER)
ACCESS TO MEDICAL : October 26, 2007
IMAGE DATA)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO FINAL OFFICE ACTION

Sir:

This is in response to the Office Action dated July 26, 2007. Claims 1 to 15 are in the application, of which Claim 1 is still the only independent claim. Reconsideration and further examination are respectfully requested.

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Claims 1 to 7 and 13 to 15 were rejected under 35 U.S.C. § 103(a) over U.S. Patent 6,574,742 (Jamroga) in view of U.S. Patent Application Publication 2002/0099652 (Herzen); and Claims 8 to 12 were rejected further in view of U.S. Patent 5,851,186 (Wood). The rejections are respectfully traversed.

As a first basis for traversal, in entering these rejections, the Office action stated that Claims 2 to 7 had not been amended (see page 4) and that Claims 8, 9, 11 and 12 had not been amended (page 6). These statements are not correct. These claims are all dependent claims, and while it is true that the precise words of the dependent claims had not been amended, it is equally true that independent Claim 1 had been amended. Since a dependent claim is directed to a combination of the subject matter of its independent claim together with its own additional recitations, it naturally follows that all of the claims in this application have been amended. See MPEP § 608.01(n):

“Examiners are reminded that a dependent claim is directed to a combination including everything recited in the base claim and what is recited in the dependent claim. *It is this combination that must be compared with the prior art, exactly as if it were presented as one independent claim.*” (Page 600-91, emphasis added.)

Thus, even though the precise wording of many of the dependent claims has not been changed, that fact does not absolve the PTO of its responsibility for a fresh examination of the dependent claims, in view of changes and arguments made with respect to the independent claim. It was wrong, therefore, for the PTO to rely on its prior rejections, since those rejections no longer apply. For example, page 4 of the Office Action treats dependent Claims 2 through 7 as follows:

"Claims 2 to 7 have not been amended, and Applicant does not appear to argue the separate patentability of these claims. As such, *Claims 2 to 7 are rejected for the same reasons as given in the previous Office Action* (Paper No. 3-4), and incorporated herein." (Emphasis added.)

However, the previous Office Action entered a rejection of Claims 2 to 7 under 35 U.S.C. § 102(e) over Jamroga alone. Since the instant Office Action enters a rejection of Claims 2 to 7 under § 103(a) over a combination of Jamroga and Herzen, and not over Jamroga alone, it is simply not possible for Claims 2 to 7 to be "rejected for the same reasons given in the previous Office Action." In particular, Applicants are entitled to a fresh analysis of dependent Claims 2 to 7. Moreover, and particularly in view of the PTO's shift in the statutory basis for rejection, from § 102 to § 103, Applicants are entitled to an articulated rationale as to what would have prompted a person of ordinary skill in the art to combine Jamroga and Herzen in a way that would have resulted in the subject matter claimed in Claims 2 to 7.

A like argument applies to Claims 8, 9, 11 and 12, which page 6 of the Office Action states "are rejected for the same reasons given in the previous Office Action". Since the previous Office Action rejected these claims over Jamroga in view of Wood, whereas the instant Office Action rejects them over Jamroga in view of Herzen and further in view of Wood, it is clear that the "same reasons given in the previous Office Action" cannot apply.

Turning to a second, and technological basis for rejection, Applicants respectfully submit that even in the cited combination, the combined teachings of Jamroga, Herzen and Wood would not have resulted in the present invention. More particularly, the

invention concerns sharing of access to medical image data stored at a central server. A payer is provided with access to the stored medical image data for a fee. In addition, the payer can forward access to another individual. Access is forwarded to the other individual by the payer, and the other individual is thereafter granted access to the same digital medical image data that the payer also has access to.

In rejecting Claim 1 over Jamroga in view of Herzen, the Office Action conceded that Jamroga does not discuss the concept of a payer forwarding access to another individual. Herzen was relied on for this feature, but Applicants respectfully submit that such reliance is misplaced.

Herzen, in the portions cited and relied on by the Office Action, describes a financial transaction between a payor and a payee. The goal of this transaction is to allow a payee to print a financial instrument 640, such as a money order, a personal check, a government check, a rebate coupon or a traveler's check. See Herzen, paragraph [0066] through [0073]. The payor sends an email message to the payee, wherein the email message is structured as shown in Figure 8 to include an authorization code 820. Examples of the text of the email message are shown in Table II at page 5 of Herzen. For example, if the financial instrument is a money order or personal check, the message might read as follows:

“John Doe has made a payment of \$100.00 available to you. To accept and receive this payment, enter the password ‘a1b2c3d4’ at www.moneyordersonline.com. You will then be able to print a check for the amount of payment using your web browser and printer.” (Herzen, Table II at page 5.)

Upon receipt of the email message, which might be received directly from the payor or via a financial intermediary, the payee is able to access and to print the financial instrument 640 on his printer. The payee then presents the financial instrument 640 to a financial institution of his choice for payment.

The system of Herzen thus differs significantly from the invention herein, since it does not involve access that is shared. According to the present invention, access to stored digital medical image data is shared by both a payer as well as another individual to which access has been forwarded by the payer. In the Herzen system it is only the payee that has access to the financial instrument. Indeed, given the very nature of Herzen, which is forwarding access to a financial instrument, it would not be sensible for this access to be shared with anyone. More particularly, those of ordinary skill would recognize that only one single person should have access to a financial instrument, and that individual is the payee and the payee alone. No other individual should ever be able to obtain access to this financial instrument, for reasons concerning fraud, double payment, embezzlement, etc.

It is therefore respectfully submitted that those of ordinary skill would find no reason to combine Jamroga with Herzen. Jamroga contemplates access to stored medical image data by a single person, namely, the participant who pays for such access. It does not contemplate shared access. Likewise, Herzen describes access by only a single individual, namely the payee. It also does not contemplate shared access. In fact, those of ordinary skill would readily concede that shared access to the financial instruments of Herzen would be contrary to ordinary and expected usage in financial transactions.

Moreover, even if Herzen and Jamroga were combined, such a combination would still not result in the invention, since it would still result in a system wherein access was limited to only a single individual.

Other aspects of the shared access according to the invention are also not seen in the combination of applied references. For example, dependent Claim 14 specifies that the other individual is granted access for a limited time. The Office Action cites to Herten's paragraphs 66 through 73, and to Figures 8 and 14, but there is absolutely no mention in any of these portions of Herzen of access for a limited time.

Likewise, dependent Claim 15 specifies that there are limitations on the power of the payer to forward access to other individuals. Again, no such disclosure is found in any of the cited portions of Herzen, despite statements in the Office Action otherwise.

The patent to Wood has been reviewed, but is not seen to add anything to the above-noted deficiencies in Jamroga and Herzen.

It is there respectfully submitted that the claims herein define subject matter that would not have been obvious from any permissible combination of Jamroga, Herzen and Wood, and allowance is respectfully requested.

Applicants' undersigned attorney may be reached in our Costa Mesa, California office at (714) 540-8700. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,



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